

**From:** Stuart Goldstein  
**Sent:** Friday, February 22, 2013 10:37 AM  
**To:** RCE outreach  
**Subject:** Comments on RCE

Please see the attached memo.

Thank you for your consideration.

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## M E M O R A N D U M

**To:** USPTO

**Subject:** Comments on Request for Continuing Examination

**Date:** February 22, 2013

I am currently a practicing patent attorney. As a former examiner, I recall the prior, accepted practice which generally required that, in accordance with MPEP § 706.07(a), a second office action could not be made final if a new ground of rejection utilizing new prior art, was relied upon by the examiner. I believe the current practice of automatically making the second rejection final is a significant factor in the increased RCE filings.

In the past, § 706.07(a) was construed fairly, i.e. in favor of the applicant. The examiner was charged with performing the best possible prior art search when he or she initially examined the application. If new prior art was subsequently found, fairness dictated that the applicant be allowed to address this new prior art and the new rejection upon which it is based, without the restrictions imposed when a rejection is made final. It was the exception, rather than the rule, that the rejection was made final, since a thorough initial search was expected to cover all “limitations which should reasonably have been expected to be claimed.”

Unfortunately, the current practice, in effect for a number of years, is, in my opinion, contrary to the spirit and intent of § 706.07(a). The USPTO now requires that this section be interpreted with a bias against the applicant and in favor of perceived expediency in the prosecution of applications. Any second action following the initial office action is routinely made final, and, in practically all cases, without comment or explanation. This is the case whether there are wholesale revisions to the claims or whether the claims are just changed

slightly to overcome the cited prior art. Regardless of the circumstances, the examiner automatically sends out a final rejection, apparently taking the position that any amendment to a claim never includes “limitations which should reasonably have been expected to be claimed.” In effect, any revision to the claim, regardless of the content or scope, is one which the USPTO considers to be a new limitation never initially contemplated by the examiner.

All too often, after submitting an amendment in response to an office action, I am frustrated to receive the examiner’s response, in which the initial rejection is withdrawn because the amended claims now overcome the originally cited prior art, but a brand new rejection, with new prior art of the claims, is stated and is made final. And it is usually the case that the claims I have amended include limitations which are not so surprising or new that the examiner would not have reasonably expected that the invention would be claimed as such. It is equally frustrating when the new rejection, made final, is based on prior art which is more relevant than that which was initially cited. Isn’t the applicant entitled to be provided with the most comprehensive search and best prior art before the first office action is sent?

What was obviously an attempt, by the USPTO’s final rejection practice, to shorten the prosecution of applications by effectively making all second actions final, has become a significant factor in the increased number of requests for continuing examinations. Faced with a premature final rejection, an RCE is often the most expeditious and cost effective course of action - hence the large volume of RCEs.

Reverting to the prior practice of adhering to the spirit and intent of § 706.07(a), which treats the applicant fairly and, significantly, takes into account the limited resources of most individual inventors and small companies, would serve to curb RCE filing significantly.

In addition, consider requiring a more thorough initial search of the prior art by the examiner, in accordance with MPE § 904, which, in fact, requires that the search “cover the invention as described and claimed, including the inventive concepts towards which the claims appear to be directed.” This would also materially enhance the process. A comprehensive initial examination fully educates the applicant, so that the amendment filed in response to the first office action could address all relevant prior art, thereby more effectively advancing the prosecution of the application, leading to its ultimate disposition, without the necessity of drafting and sending out a final rejection or filing an RCE.

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